

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 5 has been withdrawn.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-13 are now pending in this application with claim 5 being withdrawn.

Double Patenting

Claims 1-13 were rejected on the ground of nonstatutory double patenting over claims 1-14 of U.S. Patent No. 7,077,489. In response, a terminal disclaimer has been filed concurrently with this response. Copies of the assignments are attached. Accordingly, reconsideration and withdrawal of the rejection is requested.

Claim Rejections under 35 U.S.C. § 102

Claims 1-2, 6-8 and 11-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,645,327 ("Austin").

Applicant relies on M.P.E.P. § 2131, entitled "Anticipation – Application of 35 U.S.C. § 102(a), (b) and (e)" which states, "a claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Applicant respectfully submits that Austin does not describe each and every element of the claims.

Independent claims 1 and 11 are directed to an apparatus for data printing and data writing to a memory tag on or in a base medium. Independent claim 12 is directed to a method for data printing and data writing to a memory tag on or in a base medium. The claimed apparatus for carrying out the claimed method includes a print head for printing onto the base medium, and a memory tag write device for data writing to the memory tag on or in the base medium, wherein the base medium is moved along a first axis through or past the

apparatus, and at least a part of the memory tag write device required for communication with the memory tag is moveable relative to the base medium back and forth along a second axis substantially perpendicular to the first axis.

Accordingly, the claimed invention provides a significant advantage over the prior art in that the data can be written to one or more memory tags on a base medium at the same time that data is printed onto the base medium. This enables much more rapid production of documents having both visible and electronically stored data.

In contrast, Austin does not disclose each and every element of the claimed invention. Austin is directed to an RF tag application system. However, Austin fails to disclose, teach or suggest an apparatus or method “wherein the base medium is moved along a first axis through or past the apparatus, and at least a part of the memory tag write device required for communication with the memory tag is moveable relative to the base medium back and forth along a second axis substantially perpendicular to the first axis.” In making the rejection, the Examiner asserts that element 44 of Austin anticipates a memory tag write device. Then, the Examiner asserts that element 44 moves back and forth (in and out of the page) on an axis perpendicular to the base medium. The Examiner cites col. 5, line 47- col. 7, line 5 in support of this assertion.

However, a careful reading of the passages cited by the Examiner does not provide any support for the assertion that element 44 moves back and forth, moves in and out of the page or moves perpendicular to the base medium. M.P.E.P. § 2131 states that “[t]he identical invention must be shown in as complete detail as is contained in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Here, Austin does not disclose or contemplate any such movement. Accordingly, Austin does not disclose, teach or suggest an apparatus or method “wherein the base medium is moved along a first axis through or past the apparatus, and at least a part of the memory tag write device required for communication with the memory tag is moveable relative to the base medium back and forth along a second axis substantially perpendicular to the first axis.”

Accordingly, Applicant respectfully requests that the rejection be withdrawn and claims 1, 11 and 12 be allowed. Further, claims 2-4, 6-10 and 13 depend from one of

independent claims 1, 11 or 12 and should be allowed for the reasons set forth below without regard to further patentable limitations cited therein.

If this rejection of the claims is maintained, the examiner is respectfully requested to specifically point out where the above-mentioned features are disclosed in Austin.

Claim Rejections under 35 U.S.C. § 103

Claims 3-5 and 9-10 were rejected under 35 U.S.C. § 103 as being unpatentable over Austin in view of U.S. Patent No. 6,857,714 ("Hohberg").

As stated above, Austin fails to disclose, teach or suggest each and every element of independent claims 1, 11 and 12. Claims 3-5 and 9-10 depend from independent claim 1 and should be allowed for the reasons set forth above. Further, Hohberg fails to cure the deficiencies of Austin. Accordingly, Applicant requests that the rejection be withdrawn and claims 3-5 and 9-10 be allowed.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 C.F.R. § 1.25. Additionally, charge any fees to Deposit Account 08-2025 under 37 C.F.R. § 1.16 through § 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

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By  _____

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